

REMARKS

This response cancels claim 2 without prejudice or disclaimer, amends claims 1, 5-15, 23-25, and 39-40 and adds new claims 41-61. In Paper No. 9, the Examiner withdrew claims 3, 4, 16-22 and 26-38 from consideration. Accordingly, claims 1, 5-15, 23-25, and 39-61 are pending in the present application.

By action taken here, applicants in no way intend to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicants expressly reserve all such equivalents that may fall in the range between applicants' literal claim recitations and combinations taught or suggested by the prior art.

Interview

Counsel thanks Examiner Ricigliano for speaking with Applicants' representatives on February 16, 1999. Although no agreement was reached during the interview, Applicants' representatives discussed differences between the present invention and the prior art and discussed draft amendments.

I. **Rejection of Claims 1, 2, 5-15, 23-25 and 39-40 Under 35 U.S.C. §112 ¶1**

Claims 1, 2, 5-15, 23-25 and 39-40 were rejected under 35 U.S.C. §112, first paragraph, "because the specification, while being enabling for the deposition of electroplatable materials, does not reasonably provide enablement for one or more source materials." In particular, the Examiner stated that the "specification fails to give adequate direction and guidance as to how to apply biological sensitive molecules, redox sensitive molecules and numerous other compounds such as diamonds . . . to the array."

Applicants respectfully disagree with the rejection. The specification enables one of ordinary skill in the art to use the invention recited in the claims. The Applicants provide many examples describing the use of the invention. These examples include electrochemical deposition of inorganic compounds (Examples 1-3 and 5) and organic polymers (Example 4). Furthermore, in a Supplementary Information Disclosure Statement filed separately (Paper

No. 11), Applicants provide examples of electrochemical deposition of “biologically sensitive materials,” including porphyrins, metalloporphyrins and glucose oxidase. Examples in the Supplemental IDS demonstrate one of ordinary skill in the art could use the claimed apparatus to make an array of biologically sensitive molecules without undue experimentation.

Although Applicants disagree with the enablement rejection, Applicants have amended claims 1, 5-15, 23-25 and 39-40 to expedite prosecution. By amending the claims, Applicants neither acquiesce nor concede the rejection is proper, and reserve the right to further traverse the rejection in a continuing application. Claim 1, as amended, recites that the source materials are “are inorganic compounds or electro-polymerizable monomers.” Similarly, claim 39, as amended, recites that the “plurality of materials are inorganic compounds or polymers.” Examples of these types of source materials and materials formed by electrochemical deposition are described in detail in Examples 1-5 of the specification.

II. Rejection of Claims 1, 2, 5-15, 23-25 and 39-40 Under 35 U.S.C. §112 ¶2

Claims 1, 2, 5-15, 23-25 and 39-40 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. With respect to claims 1, 2, 5-15, and 23-25, the Examiner stated that Applicants’ definition of source material “encompasses every known material in the universe and it is unclear what is or is not a source material.” With respect to claims 39 and 40, the Examiner stated that the phrase “associated with” is vague and indefinite. Applicants respectfully disagree with both rejections. Contrary to the Examiner’s assertion, source material can not include every known material in the universe since, according to claim 1 (as filed) “components of said source material . . . deposit at said spatially addressable, predefined locations” in response to “said spatially varying potential.” That is, the source material—or components of the source material—must be capable of depositing at predefined regions of the substrate as the result of an applied voltage or amperage, which limits the scope of permissible source materials. Second, the Examiner has provided no reasons why he believes the phrase “associated with” in claim 39 is unclear and has provided no guidance on how to clarify the language.

Although Applicants disagree with the indefiniteness rejections, Applicants have amended claims 1, 5-15, 23-25 and 39-40 to expedite prosecution. By amending the claims, Applicants neither acquiesce nor concede the rejections are proper, and reserve the right to further traverse the rejections in a continuing application. Claim 1, as amended, recites that the source materials are “inorganic compounds or electro-polymerizable monomers.” In claim 39, Applicants have replaced claim language reciting “means associated with said plurality of electrodes for testing” with “a detector coupled to the plurality of electrodes for measuring the electrical property.”

III. Rejection of Claims 1, 2, 5, 8-13, 23-25 Under 35 U.S.C. §102(b)

Claims 1, 2, 5, 8-13, and 23-25 were rejected under 35 U.S.C. §102(b) as being anticipated by Falkner (claims 1, 2, 9, 10, 12, 13 and 23), Fabel et al. (claims 1, 2, 5, 8-10, 12, 13 and 23-25), Kubelik (claims 1, 2, 5, 8, 9, 12 and 23-25), Payne (1, 2, 9, 12, 13 and 23-25) and Imamura (claims 1, 2, 9, 12, 13 and 23-25). Applicants have amended claim 1 to include the limitation that “components of at least two of the predefined regions are different.” None of the prior art of record discloses this limitation. Therefore, Falkner, Fabel et al., Kubelik, Payne and Imamura do not anticipate claim 1 or claims 5, 8-13, 23-25 which depend on claim 1.

IV. Rejection of Claims 10 and 11 Under 35 U.S.C. §103(a)

Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inamura. As discussed above, Applicants have amended claim 1 to include the limitation that “components of at least two of the predefined regions are different.” Since Inamura does not disclose this limitation, it can not render obvious claims 10 and 11, which depend on claim 1.

V. New Claims 41-58

Applicants add new claims 41-61 that also distinguish the present invention from the prior art of record. Applicants believe the specification supports the limitations recited in claims 41-61.

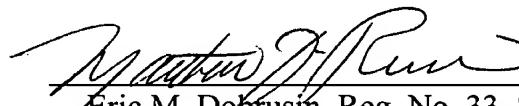
VI. Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1, 5-15, 23-25 and 39 and 40, as amended, and new claims 41-61 are patentable over the prior art of record. If the Examiner has any questions, he is encouraged to telephone Applicants' counsel.

It is believed that any fees due with respect to this paper have been identified in an accompanying transmittal. However, if additional fees are required in connection with the filing of this paper, and such fees have not been identified in the accompanying transmittal, permission is given to charge account number 50-0496.

Respectfully submitted,

Date: March 19, 1999



Eric M. Dobrusin, Reg. No. 33, 867
Matthew J. Russo, Reg. No. 41,282
RADER, FISHMAN & GRAUER PLLC
1533 N. Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304
(248) 594-0624
Attorneys for Applicants

R0048485